

REMARKS

Claims 1-20 are pending. By this Amendment, claims 6, 13 and 14 are amended.

Claims 7-11 and 15-20 have been withdrawn from consideration. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 6, 13 and 14 under 35 U.S.C. §112, second paragraph for failing to include the word "and" preceding the last claim element in each claim. Applicants have amended claims 6, 13 and 14 to obviate this rejection. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection Under 35 U.S.C. §102(b)

The Office Action rejects claims 1 and 2 under 35 U.S.C. §102(b) over JP 6246777 to Suzuki et al. ("Suzuki"). Applicants respectfully traverse the rejection.

Suzuki does not disclose each and every element of claim 1. Claim 1 recites "[a]n insertion-molded cylindrical article, comprising a cylindrical molded body having an inner surface, a mark of an injection gate opening positioned on said inner surface, and a barrel portion having an outer surface, and a sheet-shaped insert having an upper end; wherein said

insert is bonded to said outer surface of said barrel portion, and wherein said mark is positioned at said inner surface of the cylindrical molded body while being inwardly apart from said upper end of said insert in an axial direction and at a position corresponding to a position on said inner surface that is covered by said insert." (emphasis added). Suzuki does not teach such an article.

The Office Action asserts that the molded article of Suzuki includes a mark of an injection gate positioned on the inner surface of the cylindrical body while being inwardly apart from the upper end of the insert in an axial direction. The Office Action reasons that the gate mark would be so located because "the runners which connect the injection gate and the cavity are directed to the inside surface of the insert and are not directed to the upper end of the insert." Notwithstanding these insertions, it would be impossible for the molded article of Suzuki to include a gate mark positioned as set forth in claim 1.

The gate mark of the molded article of claim 1 is positioned at the inner surface of the cylindrical molded body and inwardly apart from said upper end of said insert in an axial direction. The gate mark is also at a position corresponding to a position on said inner surface that is covered by said insert. The injection gates 32 (and thus the gate marks) in the mold of Suzuki are positioned at the top of the mold, above the location of the blank board 103. It is apparent in every figure of Suzuki that the injection gates 32 are situated at the portion of the mold corresponding to the narrow throat of the resulting molded article. Viewing FIG. 2 of Suzuki, the injections gates correspond to the location of the threading for accommodating a screw cap. The blank board 103 on the molded container is positioned below the narrow throat of the container at the wider body portion. See Suzuki, FIG. 2. As the gate marks of the molded container of Suzuki are necessarily at the narrow throat of that container, they cannot be said to be "at a position corresponding to a position on said inner surface that is covered by said insert," as provided in claim 1.

The Office Action further posits that "[t]he method of making the cylindrical body (product-by-process), and the position of the marks which result from the method, are given little patentable weight." The location of the gate marks, as provided in claim 1, is not a process step, but rather a structural feature. Accordingly, for the purposes of maintaining a rejection under §102, the gate marks should be given every bit as much patentable weight as any other structural feature.

Claim 1 is not anticipated by Suzuki. Claim 2 depends from claim 1, and thus also is not anticipated by Suzuki. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §103(a)

The Office Action rejects claims 3-6 and 12-14 under 35 U.S.C. §103(a) over Suzuki in view of JP 3286815 to Asahi Chemical ("Asahi"). Applicants respectfully traverse the rejection.

Suzuki does not teach or suggest the invention of claim 3. Asahi does not cure the deficiencies of Suzuki. Claim 3 recites "[a] method for making an insertion-molded cylindrical article using an insertion injection molding mold ... said method comprising ... injecting a molten resin through said injection gate opening toward said molded body inner surface at a position inwardly apart from said upper end of the insert in an axial direction and at a position corresponding to a position on said molded body inner surface that is covered by said insert ..." (emphasis added). Suzuki in view of Asahi would not have rendered obvious such a method.

As discussed above, the injection gates 32 in the mold of Suzuki are positioned at the top of the mold, above the location of the blank board 103. Accordingly, molten resin is not injected at a position corresponding to a position on said molded body inner surface that is covered by said insert, as in claim 3. Asahi (abstract) does not provide any teaching or

suggestion with respect to a position at which molten resin should be injected in an insert molding process. Suzuki teaches an insert molding process in which resin is injected at a position above the insert (blank board). Such a method results in precisely the problems identified in the instant specification and solved by the instant inventors in the invention of claim 3. *See* instant specification, page 2, line 24-page 3, line 16. For the foregoing reasons, Suzuki and Asahi do not teach or suggest the claimed invention.

Claim 3 would not have been rendered obvious by Suzuki in view of Asahi. Claims 4-6 and 12-14 depend from claim 1, and thus also would not have been rendered obvious by Suzuki in view of Asahi. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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